

RECEIVED  
CENTRAL FAX CENTER  
JUL 19 2006

**SMART & BIGGAR**  
*Intellectual Property & Technology Law*

**To Fax no.:** 571-273-8300

P.O. Box 2999, Station D  
55 Metcalfe Street, Suite 900  
Ottawa, Canada K1P 5Y6

**Page 1 of:** 8

**Attention:** MAILSTOP AF  
(Examiner Shick C. Hom -  
Group Art Unit 2616)

Tel.: (613) 232-2486  
Fax: (613) 232-8440

**From:** R. Allan Brett

**Your file no.:** 09/466,124

**Date:** July 19, 2006

**Reply to Ottawa file no.:** 77682-111

**Time:**

**Certificate of Transmission**

I hereby certify that this correspondence is being facsimile  
transmitted to the Patent and Trademark Office Fax. No.  
(571) 273-8300 on July 19, 2006.

type or printed name of the person signing this certificate

R. Allan Brett (Reg. No. 40,476)

Signature \_\_\_\_\_

**If there are any transmission problems, please call (613) 232-2486.**

Original copy and any enclosures

☐ will  
☒ will not

be sent by

☒ mail  
☒ courier

The information contained in this transmission is confidential and only for the intended recipient identified above. If you are not the intended recipient, you are hereby notified that any dissemination or use of this communication is unlawful. If you have received this transmission in error, please immediately notify us by telephone (collect). Return the original message to us and retain no copy.

RECEIVED  
CENTRAL FAX CENTER


JUL 19 2006

Doc Code: AP.PRE.REQ

PTO/SB/33 (07/05)

Approved for use through xx/xx/200x. OMB 0651-000x  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  77682-111 /aba	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR		Application Number  09/466,124	Filed  December 21, 1999
on _____		First Named Inventor  Mitch A. Brisebois, et al	
Signature _____		Art Unit  2616	Examiner  Shick C. Horn
Typed or printed name _____			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		R. Allan Brett	
<input checked="" type="checkbox"/> attorney or agent of record.		Typed or printed name	
Registration number _____ 40,476		613-232-2486	
		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		July 19, 2006	
Registration number if acting under 37 CFR 1.34 _____		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> *Total of 2 forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/466,124 Confirmation No. 9802  
Applicant : BRISEBOIS, Mitch A. et al.  
Filed : December 21, 1999  
TC/A.U. : 2616  
Examiner : HOM, Shick C.  
  
Docket No. : 77682-111  
Customer No. : 07380

RECEIVED  
CENTRAL FAX CENTER

JUL 19 2006

Commissioner for Patents  
Alexandria, VA 22313-1450  
U.S.A.

Dear Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant requests review of the final rejections issued in connection with the above-identified application on April 19, 2006.

Claims 1, 2, 5, 8, 11, 12, 21, 22, 23, 27, 28, 30, 36, 39, 40 and 43 stand rejected under 35 U.S.C. 102(e) as being anticipated by United States patent No. 6,405,050 to Amirijoo et al. Claims 26 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Amirijoo et al. in view of United States patent No. 6,549,768 to Fraccaroli and United States patent No. 6,249,584 to Hamalainen et al. respectively.

Applicant respectfully submits that there are clear errors in the above rejections, and that essential elements required for *prima facie* rejections have not been met. In particular, the cited references do not disclose all of the limitations of the rejected claims.

To begin, Applicant points out that the present invention is directed to apparatus, networks and methods that establish private networks between mobile stations within a wireless environment, allowing for wireless data transfers between the mobile stations that are part of the private networks, while the primary reference that has been cited by the Examiner, Amirijoo, is directed to apparatus, networks and methods that are strictly limited to establishing group voice calls between mobile phone users.

Appl. No. 09/466,124

With reference to independent claim 1, this claim recites “an apparatus for controlling data unit communications between a plurality of mobile stations, each of the mobile stations having a respective maintained communication link with the apparatus, the apparatus comprising: means for grouping at least two of the plurality of mobile stations as members of a private network group; means for determining if the first mobile stations sending a data unit and a second mobile station scheduled to receive the data unit are both members of the private network group; and means for enabling communication of the data unit from the first mobile station to the second mobile station through the respective maintained communication links of the first mobile station and the second mobile station only if they are both members of the private network group”. An example of this apparatus is the Radio Network Controller (RNC) 24 in Figures 1 and 2.

At the bottom of page 4 of the Final Office Action, the Examiner equates “each of the mobile stations having a respective maintained communication link” recited in claim 1 with a notification message being transmitted to the mobile stations in the group disclosed in Amirijoo at column 5, lines 11-18. Amirijoo discloses a system in which there are at least two different types of communication links used for communication between mobile stations and a mobile services center (MSC). The first communication link is a control channel for transmitting a notification message to notify group members of a group call and identify the group call channel, as described in column 4, lines 19-21. The present application describes “a very low bandwidth connection can be permanently maintained between a mobile station and its corresponding BTS” on page 12, lines 19-20, whereas Amirijoo describes at column 1, lines 33-35, “within each cell of the group call area, a notification message is transmitted to each mobile station in the cell over a control channel”. The control channel is a broadcast channel common to all mobile stations, not “a respective maintained communication link” between each mobile station and the apparatus for controlling data communication as recited in claim 1. The second communication channel is a traffic channel, which is used for communication traffic by the respective mobile stations only after the notification message has been received and the mobile station has identified that there is a call to be received on the traffic channel. As described at column 4, lines 21-23, “after receiving a notification message, the MS (mobile station) 20 belonging to group members can tune to the channel specified in the notification message the group call channel”. As Amirijoo discloses utilizing a group call channel that “group members can tune to” only after they have

Appl. No. 09/466,124

received the notification message which specifies the channel, this is not the same as “a respective maintained communication link” as recited in the present claims.

On page 5, lines 8-14 of the Final Office Action, the Examiner has equated the “means for determining if a first mobile station...and a second mobile station...are both members of the private network group” with the mobile unit detecting if it is part of a group identified by a received group identification number sent in a notification message as recited at column 6, lines 49-60 of Amirijoo. Clearly from this description Amirijoo is disclosing that it is the mobile station itself determining whether it is a member of a group, as opposed to the apparatus for controlling data unit communications determining if the sending mobile station and a receiving mobile station are both members of a private network group. There is no indication in Amirijoo of an apparatus that specifically determines whether a sending and/or receiving mobile station is a part of a group. While the receiving mobile station is disclosed as being capable of determining whether it is a member of group, there is no suggestion that it provides this information to any other device, for example an apparatus for controlling data unit communications. The functionality of the mobile stations, as disclosed in Amirijoo, is not relevant in objecting to the claims of the present invention because the claims recite that the apparatus is in contact with “each of the mobile stations”. Therefore, the apparatus is not considered to be one of the plurality of mobile stations, rather they are mutually exclusive.

Beginning at line 14 of page 5 of the Final Office Action, the Examiner equates the “means for enabling communication”, as recited in claim 1, with the mobile station receiving a group call including a notification message having a group identification number and counter on a control channel, as described at column 2, lines 24-35 of Amirijoo. Amirijoo does not disclose “means for enabling communication of the data unit from the first mobile station to the second mobile station through the respective maintained communication links of the first mobile station and the second mobile station” [emphasis added] as recited in claim 1 because Amirijoo does not disclose enabling communication on the same “maintained communication link”. Amirijoo discloses that the traffic channel is a group call channel. The group call channel of each base station controller (BSC) is a common channel used by all group members, which is not the same as each of the mobile stations having a respective maintained communication link. Furthermore, communication in Amirijoo comprises both the notification message transmitted on the control channel and the traffic transmitted on the traffic channel.

Appl. No. 09/466,124

For at least the above reasons, Amirijoo does not disclose an apparatus having all the features recited in claim 1 and as such cannot be held to anticipate claim 1. The rejection of claim 1, as well as the rejection of claims 2, 5 and 8 which depend therefrom, is clearly in error, as there is a clear deficiency in the *prima facie* case for anticipation.

In respect of independent claims 11, 12, 22, 28, 36 and 40, these claims recite similar subject matter to that of claim 1. For at least the same reasons described above with regard to claim 1, Amirijoo does not disclose all of the features of these claims; therefore the Examiner's rejection of these claims, and claims 21, 23, 27, 30, 39 and 43 which depend therefrom, is similarly clearly in error, as at least one essential element required for a *prima facie* anticipation rejection has not been met.

Reconsideration and withdrawal of the rejection of independent claims 1, 11, 12, 22, 28, 36 and 40, and dependent claims 2, 5, 8, 21, 23, 27, 30, 39 and 43, which depend therefrom, are respectfully requested.

Dependent claim 26 depends from independent claim 22, but has been rejected as being obvious in view of Amirijoo in combination with Fraccaroli. However, Fraccaroli does not overcome the defect of Amirijoo, in that Fraccaroli also fails to disclose an apparatus comprising the "means for grouping", "means for determining", and "means for enabling communication".

The rejection of claim 26 is therefore clearly in error. An essential element of a *prima facie* obviousness rejection is a disclosure of all claimed elements in the cited references. This essential element has been omitted in the rejection of claim 26.

In addition to the Examiner's erroneous assertion that Amirijoo discloses the subject matter of claim 22, the Examiner has argued that while Amirijoo does not disclose the additional feature of "at least one of the plurality of apparatus is an intelligent peripheral coupled within a third generation wireless network", which is introduced in claim 26, this feature is allegedly disclosed in Fraccaroli at column 6, lines 45-59. Applicant's arguments beginning at line 16 of page 15 to line 11 of page 16 of Applicant's response filed January 27, 2006 absolutely refute the Examiner's argument that this feature is disclosed by Fraccaroli.

Appl. No. 09/466,124

Due to the fact that the Examiner has failed to satisfy at least one of the requirements for establishing a *prima facie* case of obviousness, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 26.

Referring now to the Examiner's rejection of claim 31 under 35 U.S.C. 103(a) as being unpatentable over Amirijoo in combination with Hamalainen, this rejection is also clearly without basis, as for at least the reasons discussed above with regard to the 35 U.S.C. 102 claim rejection of claim 28, Amirijoo does not disclose all the features of claim 28 and Hamalainen similarly fails to teach these features. For at least these reasons, the Examiner has failed to satisfy the necessary requirement that the cited references must teach all the limitations of the claim. Therefore, the Examiner has failed to satisfy at least this one requirement for establishing a *prima facie* case of obviousness.

Furthermore, the Examiner has applied hindsight analysis, beginning at line 5 of page 3 of the Final Office Action, in rejecting Applicant's arguments that there is no motivation to combine Amirijoo and Hamalainen. Therefore, Applicant re-asserts these arguments, which were presented on line 20 of page 19 to line 24 of page 20 of Applicant's response filed January 27, 2006, and maintains that there is no motivation to combine these references. Therefore Applicant submits that the Examiner has failed to satisfy a second requirement for establishing a *prima facie* case of obviousness.

In view of the foregoing, Applicant submits that the rejection of the claims are clearly in error and should be withdrawn.

Claims 1-43 are believed to be allowable over Amirijoo, Fraccaroli and Hamalainen, and early action to this end is respectfully requested.

Respectfully submitted,  
BRISEBOIS, MITCH A. ET AL.

By



Alan Brett

Reg. No. 40,746

Tel.: (613) 232-2486 ext. 323

Date: July 19, 2006  
RAB:JFS:kbc